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ORIGINAL CASE

DOCKET: 1206

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant(s): Antoine Boucher
James Fischer
Allan E Lodberg

Title : SYSTEM AND METHOD FOR INTERACTIVE DISTRIBUTION
OF SELECTABLE PRESENTATIONS

Serial no: 09/255052

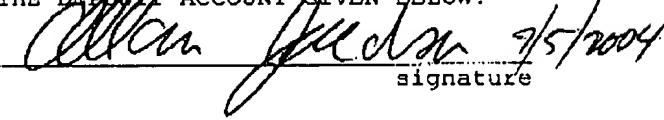
Filed: 02/22/99

Examiner: Vivek Srivastava

Art Unit: 2611

IMPORTANT: PLEASE NOTE

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signature

Commissioner for Patents
PO Box 1450, Alexandria, VA 22313-1450

Sir:-

Transmitted herewith for filing is an Appeal Brief in the above identified patent application.

Please charge the fee for filing an appeal brief in the amount of \$330.00. The Commissioner is hereby authorized to charge the above fee or any other fee due, or credit any overpayment to deposit account 10-0204.

Respectfully submitted,
BY


ALLAN J. JACOBSON

DATED: July 5, 2004

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CERTIFICATE OF FACSIMILE TRANSMISSION
703 872-9306, 23 pages including cover sheet

I hereby certify that each of the within identified papers is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): Antoine Boucher, James Fischer, Allan E Lodberg

Title: SYSTEM AND METHOD FOR INTERACTIVE DISTRIBUTION OF
SELECTABLE PRESENTATIONS

Serial no: 09/255052

Serial no: 09/255052 **Facsimile Transmission To***

Filed: 02/22/99 []

[703 872-9306]

Examiner: Vivek Srivastav

Art Unit: 2611

APPEAL BRIEF (37 CFR 1.191)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:-

Pursuant to the Notice of Appeal filed May 5, 2004 in the above identified pending patent application, Appellant hereby submits an appeal brief.

REAL PARTY IN INTEREST

The real party in interest is Liberate Technologies, San Mateo California 94403.

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RELATED APPEALS AND INTERFERENCES

None

STATUS OF CLAIMS

Claims 1-64 are canceled. Claims 65-76 are pending in the application. The examiner rejected claims 65-76 under 35 U.S.C. §103(a) as being obvious over US patent 5,961, 603 to Kunkel, et al. in view of US patent 5,815,793 to Ferguson and US patent 5,929,849 to Kikinis.

STATUS OF AMENDMENTS

The amendments dated September 21, 2002, September 17, 2003 and October 22, 2004 have been entered.

BACKGROUND

The present invention relates to the field of interactive distribution of selectable presentations i.e., systems that permit a user to select presentations of information in response to requests initiated by the user. Early systems were text based, such as teletext and viewdata, while recent systems are graphics based such as the World Wide Web portion of the Internet. The present system is applicable to providing interactive distribution of selectable presentations in a broadband signal distribution network such as a two way cable television (CATV) network.

THE CITED ART

US PATENT 5,961,603 TO KUNKEL ET AL.

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Kunkel et al. disclose a CATV system for accessing Internet web pages related to the currently viewed broadcast television program (hyperlinking). Each broadcast television program has an imbedded identification tag (ID tag) to identify a related Universal Resource Locator (URL). The viewer requests the information by pressing a button, which sends a request identifying the related URL (either directly or by noting the channel number and time of day) to the headend. At the headend, the request information is used to look up the related Web page in HTML (hypertext markup language) format, which is preferably pre-cached in HTML at the headend. A browser (74 in figure 2 of Kunkel et al.) located at the headend renders the HTML. To view the rendered Web page, user terminal is automatically retuned to a designated channel (21 in figure 2). At the end of the session, the user's terminal is retuned to the video broadcast channel to resume viewing.

US patent 5,815,793 to Ferguson

Ferguson shows an MPEG video encoding system. The examiner cites Ferguson:

"Kunkel fails to disclose... storing... in MPEG format.... The examiner takes Official Notice it would have been well known in the art to store data in MPEG format to provide compressed storage for utilizing less memory. For example, the system in Ferguson (5,815,793) teaches a VOD system comprising a [sic] archival storage which stores compressed video data.... Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify Kunkel to include the claimed limitation to provide less memory used for storage." (Final office action, February 6, 2004, page 4, last paragraph to page 5 first paragraph)

US patent 5,929,849 to Kikinis

Kikinis also discloses a CATV system for accessing Internet web pages related to the currently viewed broadcast television program. Kikinis positions an icon on the video screen, which is used to direct a local Web browser to dial up the Internet. The examiner cites Kikinis:

"Kunkel fails to disclose.... The examiner takes Official Notice it would have been well known in the art to include positional data with interactive content to provide a more pleasing viewing experience or the insure data is displayed in it's proper location on the display." (Final office action, February 6, 2004, page 5 second paragraph)

SUMMARY OF INVENTION

By way of overview, the present invention provides for interactive distribution of selectable presentations by A) receiving, converting and storing selectable presentations into MPEG digital video format, B) receiving a presentation request from the user terminal, multiplexing an MPEG digital video format selectable presentation into an MPEG digital video transport stream i.e., multiplexed along with the regular multiplexed MPEG digital video programming, C) transmitting an addressable message to the user terminal to indicate the position of the desired selected presentation in the MPEG digital video transport stream, D)

receiving the addressable message at the user terminal, locating the selected presentation in the MPEG digital video transport stream and displaying the requested presentation.

ISSUES

The issue is obviousness of the claimed invention from the cited references using the standard of obviousness under 35 USC 103.

GROUPING OF CLAIMS

The claims are grouped together as follows:

Group 1: 65, 66 and 72-76
Group 2: 67
Group 3: 68
Group 4: 69-71

Other than as indicated above, the rejected claims do not stand or fall together, and in the appropriate parts of the ARGUMENT section hereunder, Appellant presents reasons why Appellant considers the rejected claims to be separately patentable.

ARGUMENT

Group 1: claims 65, 66 and 72-76
MPEG for interactive distribution of selectable presentations

Certain features of the MPEG digital video format are particularly well suited for distributing presentations on an interactive basis. The MPEG format comprises I-frames, P-frames and B-frames.

I-FRAMES, or "intra scene" frames encode a complete screen (like when the camera cuts to a new scene).

P-FRAMES, or "predicted" frames encode only the difference from a previous reference I-frame (like when an object moves across a constant background, the motion of the object is encoded as a series of P-frames).

B-FRAMES, or "bi-directional" frames encode the difference from a previous frame, or subsequent frame, or both. (B-frames are like P-frames except that memory is required to store B-frame data until the subsequent reference frame arrives.)

The present system has notable advantages over the prior art. In particular, the MPEG decoder in the user terminal is shared between video programming and selected presentations. A digital cable box that uses MPEG for video programming already has a fast dedicated MPEG decoder. The cable box receives (via an addressable message) the PID (packet identifier) of the MPEG packet containing the selected presentation. The PID defines the position of the selected presentation in the MPEG digital video transport stream. No additional hardware is needed to generate a display because the selected presentation is also in MPEG encoded format. The digital cable box just passes the MPEG encoded selected presentation through the already present MPEG decoder for display.

Objective evidence that the use of MPEG for interactive presentations is an inventive step, not obvious to one of ordinary skill in the art at the time the invention was made, is the cited prior art references to Kunkel et al. and to Kikinis. Neither Kunkel et al. nor Kikinis or the combination of them suggest the claimed combinations.

Kunkel et al. were aware of the existence of MPEG digital video compression. Yet, Kunkel et al. only used MPEG for the normal video program, not the selectable presentation. MPEG was considered just a mere substitute for the analog video signal. Specifically, Kunkel et al. imbed the same ID tag in either the analog TV or the MPEG digital TV signal so that their system is otherwise unaltered. Thus, Kunkel et al. were aware of MPEG II but did not use it for delivering selectable presentations:

"The purpose of the uplink center 38 is not only to broadcast video programming via the satellite 26, but also to insert the ID tags in the video programming. In the case of analog television signals, this can be accomplished by inserting the ID tag in the vertical blanking interval (VBI) of the signal, or by inserting the tag in either the audio or live video stream. For digital communications, such as those based on the MPEG II format, for example, the ID tag data may be periodically (e.g., approximately once every second) inserted in a data stream associated with the particular video and audio data stream." (Kunkel et al. column 5, lines 32-43).

The use of MPEG for interactive distribution of selectable presentations was not obvious to Kunkel et al. in 1996.

Kikinis too, was aware of the existence of MPEG digital video compression but did not use it for delivering presentations:

In addition to the CPU and decoder/tuner in set-top box 11, there is a Motion Picture Experts Group (MPEG) decoder 25 for interpreting data provided to the set top box in MPEG I and MPEG II format, or future formats, and for providing signals therefrom to drive a TV or a video monitor. MPEG is an industry standard protocol for video data, and is well known in the art. (Kikinis

column 5, lines 42-48)

Yet, even with an MPEG decoder 25 in settop 11, Kikinis does not use the MPEG decoder for selectable presentations, but instead builds a Web browser and dial up modem into the settop 11:

Set-top box 11.... [in operating code 48] includes a WEB browser, and routines for specific functionality according to embodiments of the invention, described more fully below. The WEB browser is adapted to access servers on the WWW, such as server 54 shown connected to link 37. Server 54 is meant to represent any WEB server that may be dialed up through one of the modems associated with the system of FIG. 1. (Kikinis column 6, lines 1-13)

The use of MPEG for interactive distribution of selectable presentations was not obvious to Kikinis in 1996.

THE EXAMINER'S POSITION

The examiner admits that Kunkel et al. use HTML, not MPEG for encoding and caching selectable presentations. The examiner combines Kunkel et al. with Ferguson to conclude "it would have been well known in the art to store data in MPEG format to provide compressed storage for utilizing less memory..." There are several flaws in the examiner's argument:

1. There is no evidence in this case that a selectable presentation encoded in HTML uses more memory than the same presentation encoded in MPEG. Ferguson cites that there is a 200-fold advantage of compressed MPEG video

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over uncompressed video, a video to video comparison. Ferguson says nothing about the advantage of HTML versus an MPEG I-frame or MPEG P-frame. Ferguson is not relevant to the issues in this case. Whether HTML or MPEG takes less memory may well depend upon the specific presentation image to be encoded.

2. Even if MPEG encoding takes less memory storage than HTML, Kunkel was aware of the availability of MPEG encoding (column 5, lines 32-43), and he did not use MPEG to encode, store and deliver selectable presentations. Instead, Kunkel et al. chose to put a browser (74 in fig. 2) at the headend and deliver the browser image over an analog channel (21 in fig. 1). Similarly, Kikinis chose to include a dial up modem (35 in fig. 1) and browser (Operating code 48 in fig. 1) in the terminal, even though an MPEG decoder 25 was present in the settop box 11.
3. The examiner has cited no prior art to support the proposition that reduced memory storage at the headend is the universal goal of all interactive presentation systems. Improved use of available bandwidth, compatibility with existing hardware and reduced receiver cost are also valid design goals. It is not uncommon in a broadcast system to make the (one) transmitter more expensive if the (many) receivers can be made less expensive.

The fact that Kunkel et al. and Kikinis were skilled in the art and aware of MPEG, and still did not use MPEG to encode selectable presentations, supports appellants' position that the subject matter of claims 65, 66 and 72-76 was not obvious to one skilled in the art at the time the invention was made.

There appears to be some confusion as to the meaning of the phrase "the position of said selected presentation in MPEG digital video format in said MPEG digital video transport stream" (emphasis added) in claim 65. In particular, the examiner further supports the rejection of claims stating,

"Kunkel fails to disclose the claimed receiving position information for presenting the selected presentation. The Examiner takes Official Notice it would have been well known in the art to include positional data with interactive content to provide a more pleasing viewing experience or to insure data is displayed in its proper location on the display. For example, the system in Kininis (5, 929, 849) teaches including positional data with a URL to insure the URL is positioned correctly (see col 6 line50 - col 7 line 10). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the claimed limitation to ensure that data is correctly displayed and to enhance the viewer's experience." (final office action dated February 6, 2004, page 5, middle paragraph).

The examiner is confusing "position" on the display screen with "position" in the MPEG digital video transport stream. In the MPEG digital video format, a packet identifier, or PID, defines the

position of an MPEG frame in the MPEG digital video transport stream. The "position" in the language of claim 65 refers to the position in the MPEG digital video transport stream where the desired selectable presentation (e.g. the I-frame or P-frame) is located.

Group 2: Claim 67

I-frames for encoding selectable presentations

The bulk of presentation materials, such as are available on the Internet, are still (still-frame) images. Still images are encoded in a single MPEG I-frame. As stated in appellants' specification,

When only still-frame images are encoded according to MPEG techniques, each frame can occur within the MPEG elementary stream as an independent "I-frame." This frame arrangement is used for still-frame only images because the images are non-contiguous and therefore provide no opportunity for the "motion estimation compression" available for motion video processing. The MPEG I-frame elementary stream inclusive of 4-byte headers is packetized at 188 Bytes per packet. (Appellants' specification page 37, lines 28-33)

The use of MPEG encoded I-frames for interactive distribution of a still-frame image selectable presentation is not shown or suggested in the prior art.

Group 3: Claim 68

P-frames for encoding overlay and partial screens

Overlay images and partial screen images are efficiently encoded using P-frame frames. Graphics can be easily overlaid on top of video program images by encoding in a P-frame. P-frames are suitable for overlay graphics and text occupying less than a full screen. P-frames are therefore very efficient for overlay

text and graphics. The specification discloses the use of P-frames for efficient data overlay. The specification points out how only 37.2 Megabits of bandwidth will serve 100,000 homes using MPEG P-frames:

Incremental video images can also be provided as presentation data multimedia elements. In some embodiments, dynamic image elements, sometimes referred to as data overlays, can be MPEG P-frames with relatively few changes - perhaps only 4 pels. As an example, 4,500 pels of overlay during the viewing interval equates to 36,000 bits over 12 seconds, or an average of 3,000 bps. The average user, within the operating area so defined, thus requires about 62,000 bps (27,000 + 32,000 + 3,000) for the video, audio and overlay data. The required "channel bandwidth" of an MPEG channel to serve the 100,000 home area is (600 X 62,000), or 37.2 Megabits per second. (Appellants' specification page 37, line 34 to 38, line 8)

Whatever may be said regarding independent I-frames being analogous to analog TV's 60 independent frames per second, P-frames have no correspondence to earlier analog or digital systems. The efficiency is possible because P-frames transmit less than a complete video screen. The point is that a standard MPEG decoder, already in the settop box, will generate a data overlay from an MPEG P-frame using the same hardware that decodes P-frames for the video programming.

The use of MPEG encoded P-frames for interactive distribution of a selectable presentation is not shown or suggested in the prior art.

Group 4: 69-71
Multimedia: motion and sound

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In addition to stills, a selectable presentation may include one or more multi-media elements of motion and/or sound. MPEG accommodates such expansion into multi-media by designating more than one type of MPEG frame to be sent to the settop box.

The use of a group of MPEG encoded formats, chosen from P-frames, I-frames, B-frames, and an MPEG audio sequences for interactive distribution of a multi-media selectable presentation is not shown or suggested in the prior art.

35 U.S.C. §103

The standard test for obviousness is stated by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, '34-36, 15 L. Ed. 2d 545, 148 USPQ 459 (1966). The question of obviousness is one of law, based upon factual determinations. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052, 95 L. Ed. 2d 843, 107 S. Ct. 2187 (1987). Four considerations determine obviousness: (1) the scope and content of the prior art; (2) the differences between the claim and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any of nonobviousness.

(1) SCOPE AND CONTENT OF THE CITED PRIOR ART

Kunkel et al. put a browser at the headend and designate a channel for the user to access the headend browser:

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"In the operation of the channel hyperlinking system 10, each of the headends 14 preferably pre-caches from the ISP 30, the HTML data pertaining to the channel hyperlinks associated with upcoming programming prior to the broadcasts, and stores this information in the cache 31....

If a user viewing a program or advertisement on channel A, for example, wishes to obtain additional information related to the advertised product or television program, the user presses the channel hyperlink button 25 on the keyboard 23 to initiate the request....

When the headend 14 receives the channel hyperlink information requests from the user, the communications controller 70 sends the channel ID information to the terminal processor 96 which identifies the one of the downstream channels 21 on which the requested channel hyperlink information will be transmitted. In response, the terminal processor 96 instructs the RF tuner 94 to switch to the designated channel. The session manager 72 then connects the user to one of the available active browsers 74....

Once the user is finished browsing the downloaded information, they either actuate the hyperlink button 25 on the keyboard 23 for closing the Web page, or if they are using a mouse-type input device, they point and click on a back or exit button on the television display screen. In response, the session manager 72 closes the browser application 74 which has been delegated to the user, and the terminal processor 96 switches the tuner 94 back to the previously selected channel so that the user may resume viewing the video broadcast." (Kunkel, et al. Col 12, line 45 to column 13, line 38)

In contrast to putting a Web browser at the headend, Kikinis, puts a Web browser and dial up modem into the settop. In order to identify the URL of a Web page related to the current video program, Kikinis positions an icon on the screen:

"...one or more entity images... are ...associated with a WWW URL. As a simplified example, in an advertisement for a certain brand of automobile, an icon or emblem may be presented in each frame at a particular position in the frame.FIG. 2A is a simplified depiction of a frame 55 displayed with a BMW emblem 57 in the frame at a particular position with a specific areal extent. (Kikinis column 6, lines 50-63)

Continuing with the example of the BMW advertisement,....

If the viewer is interested in additional information, he/she may manipulate the cursor to touch the region of emblem 57 and then actuate a selection signal, such as pressing one of the buttons 69 on the remote. On receipt of the selection signal with the cursor touching the BMW emblem, the system executes browser routines, accessing the WWW, and dials up the WEB server (see server 54 and modem 35 or 39, FIG. 1) described above maintained by BMW on the WWW. The URL in the data region between frames of the TV transmission, associated with the BMW emblem is the WWW address for dial-up. (Kikinis column 7, lines 47-67).

(2) THE CLAIMED SUBJECT MATTER AND DIFFERENCES

The claimed subject matter recites the use of MPEG features, namely MPEG encoding, I-frames, P-frames, B-frames and MPEG encoded audio sequences in various combinations for interactive distribution of selectable presentations.

(3) THE LEVEL OF ORDINARY SKILL IN THE PERTINENT ART

The level of ordinary skill in the pertinent art is difficult to quantify. The field of communications in general, and interactive technology in particular has been (and is still) developing very rapidly. Numerous alternatives are typically available to achieve a similar system function. The level of ordinary skill is determined objectively.

The issue (for group 1 claims) is whether one of ordinary skill in the art at the time the invention was made would encode, store and distribute selectable presentations in MPEG encoded format to

achieve the interactive distribution of such selectable presentations. The cited art and its combinations do not result in such a system. It is pure hindsight to assume that a designer having ordinary skill in the art would add the missing elements to the disclosures of Kunkel et al. and Kikinis to arrive at the present claimed system.

The issue (for the group 2 claim) is whether one of ordinary skill in the art at the time the invention was made would use an MPEG I-frame to encode, store and deliver a selectable presentation, i.e., a still image.

The issue (for the group 3 claim) is whether one of ordinary skill in the art at the time the invention was made would use an MPEG P-frame to encode, store and distribute a selectable presentation, i.e., an overlay image or an image less than a full screen.

The issue (for group 4 claims) is whether one of ordinary skill in the art at the time the invention was made would use a group of MPEG encoded formats, chosen from P-frames, I-frames, B-frames, and an MPEG audio sequences to encode, store and distribute a multi-media selectable presentation is not shown or suggested in the prior art.

CONCLUSION

Appellants are entitled to a patent, unless it can be shown that the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains (35 USC §103). For the reasons give above, neither Kunkel et al., nor Kikinis, nor Ferguson, nor any combination thereof renders the claimed combinations obvious to one of ordinary skill in the art at the time the invention was made.

For the foregoing reasons, appellants' request that the Board of Appeals and Patent Interferences reverse the rejection of claims 65-76 by the examiner.

Respectfully submitted,
by

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APPENDIX

65. In a system for interactive distribution of selectable presentations, said system having a presentation preparation server, a broadband signal distribution head-end coupled to said presentation preparation server and to a broadband signal distribution network, and an addressable processing equipment at a user location, a method comprising:

transmitting a presentation request from said addressable processing equipment at said user location to said presentation preparation server, said presentation request including a destination address corresponding to said addressable processing equipment at said user location;

receiving a plurality of selectable presentations at said presentation preparation server;

converting said selectable presentations to MPEG digital video format;

storing said selectable presentations in MPEG digital video format in a presentation database memory;

retrieving one of said selectable presentations corresponding to said presentation request from said presentation database memory to form a selected presentation in MPEG digital video format;

multiplexing said selected presentation in MPEG digital video format into an MPEG digital video transport stream;

transmitting an addressable message to said addressable processing equipment at said user location to indicate the position of said selected presentation in MPEG digital video

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format in said MPEG digital video transport stream;
transmitting said MPEG digital video transport stream from said broadband signal distribution head-end;
receiving said addressable message at said addressable processing equipment at said user location to indicate the position of said selected presentation in MPEG digital video format in said MPEG digital video transport stream; and
receiving said selected presentation at said addressable processing equipment at said user location.

66. A method in accordance with claim 65, further comprising:

transmitting a log on request from said addressable processing equipment at said user location to said presentation preparation server;
receiving a user number from said presentation preparation server at said addressable processing equipment; and
using said user number to identify MPEG digital video signals transmitted from said presentation preparation server to said addressable processing equipment at said user location.

67. A method in accordance with claim 65, wherein said selected presentation in MPEG digital video format is an MPEG I-frame forming a still image.

68. A method in accordance with claim 65, wherein said selected presentation in MPEG digital video format is an MPEG P-frame forming a data overlay.

69. A method in accordance with claim 65, wherein said selected presentation in MPEG digital video format is a group of pictures sequence including at least one MPEG I-frame and one or more MPEG P-frames forming a video sequence.

70. A method in accordance with claim 65, wherein said selected presentation in MPEG digital video format is a combination of MPEG I-frames, MPEG P-frames and MPEG B-frames.

71. A method in accordance with claim 65, wherein said selected presentation in MPEG digital video format is an MPEG encoded audio sequence.

72. A method in accordance with claim 65, wherein said step of multiplexing said selected presentation in MPEG digital video format into an MPEG digital video transport stream includes assigning a packet identification (PID), a program association table (PAT), a program map table (PMT), and a program clock reference (PCR) to said selected presentation in MPEG digital video format, wherein one program clock reference (PCR) is used for multiple PIDS.

73. A method in accordance with claim 65, wherein said presentation request from said addressable processing equipment at said user location to said presentation preparation server is transmitted over a two-way broadband signal distribution network.

74. A method in accordance with claim 65, wherein said presentation request from said addressable processing equipment at said user location to said presentation preparation server is transmitted over a telephone line.

75. A system for interactive distribution of selectable

presentations, said system comprising:

addressable processing equipment at a user location, said addressable processing equipment transmitting a request for a presentation;

a presentation preparation server, including a receiver coupled to said addressable processing equipment at a user location for receiving said request for a presentation;

a presentation conversion utility at said presentation preparation server for encoding said selectable presentations into MPEG digital video format;

a presentation database memory coupled to said presentation conversion utility for storing said selectable presentations encoded in MPEG digital video format;

an MPEG packet multiplexer coupled to said presentation database memory;

a broadband signal distribution head-end coupled to said MPEG packet multiplexer; and

a broadband signal distribution network coupled to said broadband signal distribution head-end and to said addressable processing equipment at said user location, for transmitting said selected presentation corresponding to said request for a presentation to said addressable processing equipment at said user location,

wherein said addressable processing equipment decodes said selected presentation in MPEG digital video format for display to said user.

76. system in accordance with claim 74, wherein said presentation conversion utility is coupled to the Internet, and said request for a presentation is a designation of a Uniform Resource Locator (URL).

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